

REMARKS/ARGUMENTS

Reconsideration and allowance of the above-identified application are respectfully requested. Upon entry of this amendment, claims 1-16 will be pending in the application.

The Examiner has rejected claims 1, 3-8, 10-11, and 14-16 under 35 USC §102(b) as being anticipated by U.S. Patent No. 3,915,449 to Johnson et al. Claims 1, 2, 8 and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,053,494 to Baskette et al. Claims 12 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baskette et al. as applied to claim 9, in view of Johnson et al.

In the office action, the Examiner refused to give patentable weight to the limitations reciting a “pivot unit” because such limitations were preceded by the term “adapted to.” Applicants have amended the claims to positively recite these limitations in each of the independent claims. Accordingly, reconsideration is requested.

Neither Johnson et al. nor Baskette et al. teach or suggest “a pivot unit that sets the inclination angle of the idle roller within a predetermined range *according to a type of the paper.*” As discussed in the background of the application, when the inclination angle of an idle roller is fixed in a paper transfer apparatus, the side registration function is deteriorated when the weight of paper being transferred changes (see, e.g., p.3). If the angle is too great for the particular weight of paper, the paper is transferred to the sidewall with too much force, and the side edge of the paper is damaged. If the angle is too small for the particular weight of paper, the paper is not fully transferred to the sidewall, and accurate registration is not achieved.

Accordingly, embodiments of the present invention advantageously include a pivot unit that *sets the inclination angle* of the idle roller within a predetermined range *according to a type of the paper*. Thus, the inclination angle is set to a smaller value for lighter papers to side-register the paper with less force, thereby not damaging the edge of the lighter paper. The inclination angle is set to a higher value for heavier paper to side-register the paper with greater force, thereby assuring accurate side-registration of the heavier paper.

Neither Johnson et al. nor Baskette et al. teach or suggest this feature. Johnson et al. teaches an idle roller whose inclination angle is changed according to a solenoid that fires depending on the direction of transfer, *not* the type (such as weight) of paper being transferred, as claimed. Baskette et al. describes a pair of idle rollers whose inclination angles are adjusted together by a rack and pinion gear system. However, the angle is set according to a particular job being performed in order to alter the offset position of the particular *job*. The inclination angle in Baskette is *not* set according to the type of paper being transferred.

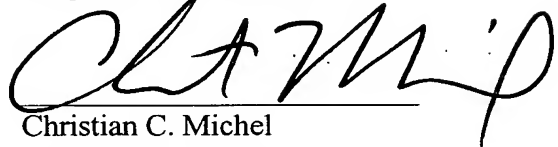
Accordingly, because neither Johnson nor Baskette teach a feature claimed in each of independent claims 1, 8 and 15, reconsideration and allowance of these claims is requested. Furthermore, dependent claims 2-7 and 9-14 incorporate all of the limitations of the respective independent claims. Thus, claims 2-7 and 9-14 should be allowed.

The Examiner is respectfully requested to enter this amendment because the limitation discussed above was present in the claims before the amendments made herein, although not given patentable weight by the Examiner due to the Examiner's position on the "adapted to" language used. The Examiner is reminded that the term

"adapted to" does not automatically render a clause optional, and thereby non-limiting, in a claim. MPEP §2111.04. The determination of whether such a clause is a limitation in a claim depends on the specific facts of the case. *Id.* Furthermore, although the Examiner argues that Johnson and Baskette could be "adapted to" set the inclination angle according to a type of paper or some characteristic of paper, the Examiner has not given an example of *how* such modification could be made, or explained how such modification would be obvious to one of ordinary skill in the art.

In view of the above, it is believed that the application is in condition for allowance and notice to this effect is respectfully requested. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the telephone number indicated below.

Respectfully Submitted,



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